REMARKS

Reconsideration and allowance of above referenced application are respectfully requested. Upon entry of this amendment, claims 1, 2, 4-45, 47, 49-66, 68-71, 73, 74, 76-81, and 83-149 will be pending in this application.

Applicant thanks the Examiner for his indication that claims 4-19, 51-53, 57-62, 65, 66, 68-74, 76-78 and 83 are allowed.

Claims 2, 124-135 and 140 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claim 2 has been amended to address the antecedent basis with regard to the claim language of the "overflow condition." Claim 140 has been cancelled.

Claims 1, 2, 20, 24, 79, 84, 88-90 and 96-101 stand rejected under 35 U.S.C. 102(b) as being anticipated by Taggart. Applicant continues to traverse the Examiner's rejection with respect to these claims, for the reasons set forth in previous amendment responses, as well as for the reasons set forth hereinbelow.

Each of independent claims 1, 2, 20, 24, 54, 79, and 98 recite, in some form, delaying a first data stream portion, and accelerating a second data stream portion to make up for the previously introduced delay time of the first data stream portion -- a combination that has been found to be very advantageous. Claim 20 has been further amended to make explicit that it requires that the subsequent acceleration make up for the previously introduced delay.

The Examiner continues to rely on the Taggart patent, and points to the recitation at column 4, lines 3-10 (which discuss the format of the data stored on the tape of Taggart) and column 5, line 60 to column 6, line 25. While all of the arguments previously made are still valid, Applicant emphasizes that Taggart does not teach or suggest delaying a second data stream portion to make up for a delay of a first data stream portion. In the Taggart tape drive system, there is no concept of making up for a previously introduced delay. The "window" of Taggart is moved to compensate "for long term variations" as taught at column 6, lines 18-19. These long term variations have to deal with the physical tape that passes the read/write heads, and as timing problems occur, clock pulses are "added or subtracted" (emphasis added) in order to either "accelerate or delay" (emphasis added) the generation of subsequent windows. It abundantly clear, however, that to the extent acceleration is used in Taggart, it is not tied in any manner to the previously introduced delay. Rather, it is tied to the characteristics that are detected at that moment in time. Thus, at no time in the Taggart system, even at the end of a tape, is there ever any need for the acceleration to make up for the previously introduced delay.

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Accordingly, the above-referenced independent claims, and the claims dependent thereon, are believed allowable.

Claims 20-24, 43, 47, 54-56, 63-64, 85-87, 91-95 112-115, 118, 129-132, 135 and 141-143 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taggart as applied to claim 1 and further in view of Fox. Applicant continues to respectfully traverse the Examiner's grounds of rejection, for the reasons set forth in previous amendment responses, as well as for the reasons set forth hereinbelow.

Initially, the Examiner refers to *In Re McClaughlin*, 170 USPQ 209 (CCPA 1971) for the proposition that "any judgment on obviousness is in a sense based upon hindsight reasoning. But so long as it take into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applications disclosure, such a reconstruction is proper" This proposition, however, was established by the CCPA in 1971, and there have been significant developments in the law that clarify what this quote means -- particularly by the Federal Circuit, the decisions of which are precedential over those of the CCPA.

Without even referring to Federal Circuit precedent, however, that the combination of Taggart and Fox does include knowledge gleaned only from the applications disclosure is easily illustrated. Taggart, the primary reference, is directed to tape drive system. Such a system requires a continuous tape and has no specific timing requirements. There would have been no reason to include characteristics of a system such as Fox, which requires regularly spaced presentation time stamps (PTS's). Clearly, given the characteristics of both of these devices, a combination would not have been attempted but for reading the applicant's specification.

Further, to the extent that *In Re McClaughlin* case does not conform to Federal Circuit precedent, it cannot be used. One legal precedent with respect to the area of the law, clearly established by the Federal Circuit, is that there needs to a suggestion of the desirability of combining two different references. *See In Re Mills* 916 F.2d at 680 (Fed. Cir. 1990). The two patents, Taggart and Fox, used in the rejection describe very different systems, but there is no teaching in either of them to combine these systems with another--and given their entirely different subject matters, there is no expectation by one of ordinary skill in the art that they would have been combined. There is also no suggestion in either of these references for the modification that has been suggested by the Examiner, as required *Id.* at 682.

Applicant also fails to see how the tape drive apparatus of Taggart, and the apparatus for preserving synchronization of Fox, can be combined without destroying the intended purpose of each of these devices, a requirement of *In Re Gordon*, 733 F.2d 900 (Fed. Cir. 1984) and asserted in the

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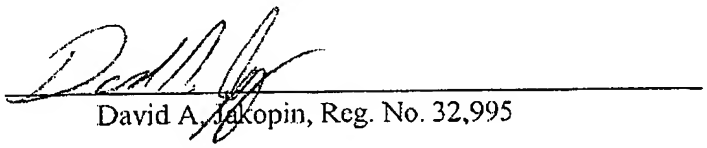
previous amendment remarks. More specifically, there is no way that the tape system of Taggart that requires a continuous tape and purposefully has no specific timing requirements can be combined with the system of Fox, which requires regularly spaced presentation time stamps (PTS's), without destroying the functionality of at least one of them.

Thus, for the above reasons, this combination is improper, and the claims are allowable.

In view of the above amendments and remarks, Applicant submits that the above-referenced application is in a condition for allowance and respectfully requests a Notice to that effect.

Respectfully submitted,

PILLSBURY WINTHROP, L.L.P.



David A. Jakopin, Reg. No. 32,995

1600 Tysons Blvd.
McLean, VA 22102
Tel. No.: (650) 233-4790
Fax No.: (650) 233-4545

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APPENDIX WITH MARKINGS SHOWING CHANGES MADE

2. (Amended 5x) An apparatus for removing an overflow condition comprising:

means for detecting a first digitally encoded data stream portion causing [an] said overflow condition;

means for delaying said first data stream portion for a delay time that prevents said overflow condition; and

means for accelerating a second data stream portion that follows said first data stream portion to substantially make-up for said delay time.

20. (Amended 2x) A method for correcting overflow of a digitally encoded data stream decoder during splicing of data stream portions including an old data stream portion and a new data stream portion, comprising causing a delay of a scheduled transmission time of at least a part of the new data stream data portion and an acceleration of a subsequent part of the new data stream portion to substantially make-up for said delay.

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